



ITW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kouhei FUJITA et al.

Group Art Unit: 3744

Application No.: 10/511,138

Examiner: J. FORD

Filed: October 14, 2004

Docket No.: 120534

For: COOLING DEVICE IN A WORK MACHINE

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the September 14, 2007 Election of Species Requirement, Applicants provisionally elect Species 1, Figures 2-6, with traverse. Claims 1-3, 5-9, 11, 12, 14, 15, 17-20, 22-28 and 30 read on the elected species and claim 1 is generic to all species.

Applicants respectfully submit that there exists *a priori* unity of invention with respect to all species by virtue of the fact that claim 1 is generic to all species. As stated in Chapter 10.07 of the ISPE (*International Search and Preliminary Examination Guidelines*):

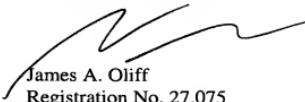
If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of generic independent claim 1 are known. See ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of generic independent claim 1 is known in the prior art. Page 3 of the Office Action asserts that the species do not relate to a single general inventive concept because generic claim 1 was allegedly deemed not patentable for the reasons set forth in the Supplementary European Search Report issued April 5, 2006. Applicants disagree with the application of the Supplementary European Search Report in order to assume that patentability will necessarily fall to one of the non-generic dependent claims because (1) the U.S. Patent and Trademark Office did not create the European Search Report, and (2) the European Search Report only indicates the relevance of a reference, and thus does not establish whether, or provide reasons why, each and every element of generic independent claim 1 is known in the prior art using the examination guidelines of the U.S. Patent and Trademark Office. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus an Election of Species Requirement at this time is improper.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,



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Date: October 11, 2007

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